

REMARKS

This is in response to the Office Action mailed on April 17, 2007, in which claims 1-11 were rejected under 35 U.S.C. 112, second paragraph and under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (U.S. Patent No. 6,029,146).

Claim Rejections - 35 U.S.C. 112

With this Amendment, claims 1-11 are amended to overcome the rejections under 35 U.S.C. 112. Specifically, these rejections are addressed as follows:

As per claims 1 and 11, the term "IT" is an acronym which is inconsistent with 112 second paragraph.

Claims 1 and 11 are amended to recite "Information Technology" rather than IT.

Also as per claims 1, 6, the phrase "in such a way..." or the "such that" language of claims 2-5, 7, 9 and 11 are considered as intended use language having no patentable weight in the respective claims.

Claims 1-11 are amended to remove the "in such a way" and "such that" language.

Also, as per claim 1, line 16, "the relevant orders" lack clear antecedent basis.

Claim 1 is amended to recite "users having placed said compatible orders" in place of "users placing the relevant orders" to overcome this rejection.

Also, what is an "Internet type" as recited on line 12?

Claim 1 is amended to remove this language.

As per claim 3, line 6, "the parameters" lack clear antecedent basis. Also, what are "internal and/or external parameters"?

Claim 3 is amended to remove "the" before "parameters" so as to correct the problem of antecedent basis. Also, claim 3 is amended to recite "internal and/or external

conditions or parameters of other orders." This language is supported in the specification of the application as filed, such as at page 22, lines 9-26.

As per claims 3 and 8, what does it mean by "the conclusion of the order(s)"? Also, regarding claims 3 and 8, the phrase "for example" renders the claims indefinite....

Claims 3 and 8 are amended to delete the language "the conclusion of the orders" and replace it with "fulfillment of the orders." Claims 3 and 8 are also amended to delete the "for example" language.

As per claim 4, the phrase "may occur" renders the claim vague and indefinite....

It is respectfully submitted that the language of claim 4 is not vague or indefinite when read in context. The claim recites that analysis means match compatible orders and indicate that a transaction may occur. The "transaction may occur" language is a particular condition, which means that a transaction is permitted to occur, based on whether there are users that have placed compatible orders that can be matched with one another (as mentioned in claim 1, from which claim 4 depends). This language is therefore definite in the context of claim 4.

Claims 6 and 7 provide for the use of achieving certain steps or stages or results, but remain unclear what method/process applicant is intending to encompass. ... Claims 6 and 7 are also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101.

Claims 6 and 7 are amended to recite proper process steps.

As per claim 8, line 6, "the parameters" lack clear antecedent basis. Also what are "internal and/or external parameters"?

Claim 8 is amended to delete "the" before "parameters" and thereby take care of the antecedent basis problem. Also, claim 8 is amended to recite "internal and/or external conditions or parameters of other orders." This language is supported in the specification of the application as filed, such as at page 22, lines 9-26.

As per claim 11, the intended use language of "said system being more particularly intended to collect all the interests of the traders of the plurality of banks" are considered as intended use language having no patentable weight in the claim. Also, "the plurality of banks" lacks clear antecedent basis.

Claim 11 is amended to replace the "more particularly intended" language with "configured." Also, "the plurality of banks" has been replaced with "a plurality of banks" to take care of the antecedent basis problem.

The claims are also replete with alternative language of "and/or" rendering the claims vague and indefinite.

It is respectfully submitted that alternative language in a claim does not render the claim vague and indefinite. See M.P.E.P. 2173.05(h). The and/or language used in the claims clearly conveys non-exclusive or logic to the combinations recited, and the claims are therefore definite.

Claim Rejections – 35 U.S.C. 102

Claims 1-11 were rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (USP 6,029,146).

Independent claim 1 recites a system for processing orders to buy and sell financial instruments to generate an automated transaction. The system automatically generates the transaction when at least two compatible orders have been matched.

Before generating a transaction, the system automatically allows a call for buy and sell "bids" to be organized in real-time or pseudo-real time among the users connected to the system. See, e.g., page 2, lines 12-16 of the specification. As shown in Figs. 1a and 1b and described at pages 6-8 of the specification, systems are currently known which allow transactions to be made manually between traders. However, the present invention allows the transactions to be generated automatically when compatible orders are matched together.

The Hawkins et al. patent discloses an automated trading confirmation system, which is able to match an originating broker's orders with the executing broker's confirmation. The Hawkins et al. system allows for direct broker-to-broker trading that will automatically match an investor's order with an executing broker's confirmation. As column 1, line 24 explains, "one area in need of improvement in efficiency is broker to broker trade confirmations. This is a business process for confirming and setting the orders placed between brokers from various regions of the world."

Notably, the object of the Hawkins et al. system is to automatically match an order and its confirmation after a transaction has been made. By contrast, the claimed invention is a system for carrying out an automated transaction between orders placed by users.

Moreover, the claimed invention is a system suitable for use in over-the-counter (OTC) markets, and can therefore be applied to "intraday" or "extraday" transactions (see page 18, lines 21-24). This is not the case for the Hawkins et al. system, which is directed only to organized markets. In organized markets, companies are not authorized to place orders themselves, but instead must provide their orders to executing brokers who are authorized by the financial institution to place orders. Thus, the Hawkins et al. patent at the very least does not disclose "analysis means to match compatible orders, indicate that a transaction may occur between users having placed said compatible orders, and automatically generate a transaction."

Because the Hawkins et al. patent does not disclose, teach or suggest each and every element recited in independent claim 1, as amended, the rejection of claim 1 under 35 U.S.C. 102(e) should be withdrawn.

Claims 2-5 and 11 depend from amended independent claim 1, and for at least that reason are allowable therewith.

Independent claim 6 recites a process for processing orders to buy and sell financial instruments to generate an automated transaction. Similar to claim 1, the process automatically generates the transaction when at least two compatible orders have been matched. For the same reasons discussed above with respect to claim 1, the Hawkins et al. patent does not disclose each and every element recited in independent claim 6, as amended, and the rejection of claim 6 under 35 U.S.C. 102(e) should accordingly be withdrawn.

Claims 7-10 depend from amended independent claim 6, and for at least that reasons are allowable therewith.

CONCLUSION


In view of the foregoing, all pending claims 1-11 are in condition for allowance. A notice to that effect is respectfully requested.

The Examiner is cordially invited to contact the undersigned at the telephone number listed below if such a call would in any way facilitate the allowance of this application.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 8/6/07

By: 

Alan M. Koenck, Reg. No. 43,724

THE KINNEY & LANGE BUILDING

312 South Third Street

Minneapolis, MN 55415-1002

Telephone: (612) 339-1863

Fax: (612) 339-6580

AMK